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U.S. PTO Box Comments - Patents

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Date : 21-Nov-96

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21 November, 1996

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Attention: Jeffrey V. Nase  
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Sir,

The following comments are submitted on the proposals to amend the rules of practice in patent cases (60 FR 49820, Docket No. 960606163-6163-01, RIN 0651-AA80).

## **1.116(A), 116(b).**

The proposed change to 1.116(a) limits the ability to enter amendments after final to those which cancel rejected claims or comply with requirements as to form. The comments state that amendments which place the application in condition for allowance may be entered under the authority of the examiner. The change to 116(b) requires a continuing prosecution application (CPA) to be filed with any amendment which is not in compliance with paragraph (a) "to ensure its consideration".

First, the expectation that examiners would exercise discretion to enter amendments not strictly complying with 1.116(b) may be overlooked when the rules enter into force and the official commentary is left behind. If it is intended to give the examining corps discretion to enter amendments, that should be expressly provided in the rules.

Second, a CPA is a request to expressly abandon the prior application as of the filing date of the CPA (1.53(b)(3)(i)(B)). The filing of a CPA as required by 1.116(b) therefore has the effect of removing the ability either consider or to enter any amendment which might place the application in condition for allowance: if an application has been abandoned it has been removed from the examiner's jurisdiction. Certainly, there is no reason for an examiner to consider an amendment to an

application which the applicant has expressly abandoned. The proposed change therefore faces the applicant with the unenviable necessity of destroying the application in order to save it.

Whatever the merits of limiting the right of amendment after final, the proposed change to 116(b) places applicants in an untenable position. The proposed change should be withdrawn.

**1.121(a)(2)(ii)**

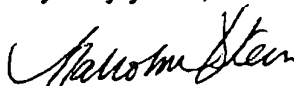
The proposed change requires a separate complete copy of all pending claims to be submitted in addition to the the submission with markings as required by 121(a)(2)(iii). While this proposed change will facilitate the review of the claims by the Examiner and provide the printer with a current version of the claims, it represents a continued burden on applicants. This burden is exacerbated by the fact that under the proposed change to 121(a)(2)(iv), omission of any claim is treated as a direction to cancel the claim. Applicants must therefore not only exercise considerable care in preparing the separate copy of the claims but must also retype the claims to remove the markings required under 121(a)(1)(iii).

In view of the burden imposed, reconsideration of the proposed change is urged.

The burden on Applicants could be alleviated if Applicants were given the option of making the markings required by 121(a)(1)(iii) using the Revisions function of commercial word processing software such as WORD or WORDPERFECT. This function permits revisions to be entered in a document with additions shown by underlining and deletions shown by strikethrough. The document can printed with these revisions after which the revisions can be merged into a clean copy of the revised document. The ability to use the well established word processing functions would enable applicants to comply with the separate copy requirement more easily. Since the strikethrough function is widely used to mark revisions to documents, it is believed that it would be as well understood within the Office as an alternative to the bracketing form of marking. In fact, strikethrough marking provides a better indication of the extent of a deletion since it gives a continuous visual indication throughout the deletion in contrast to brackets which may searching to find both paired brackets.

It is therefore suggested that if 121(a)(2)(ii) is retained, 121(a)(1)(iv) should be amended to permit (but not require) the use of strikethrough to mark deletions.

Very truly yours,



Malcolm D. Keen